

Amendment
U.S. Patent Application Serial No. 09/725,850

REMARKS

Claims 19, 31 and 43 have been amended.

Claims 1 - 23, 25 - 35 and 37- 44 are pending in the subject application.

With respect to the claim amendments, claims 19, 31 and 43 have been amended to recite the features of the card being directly insertable into a personal computer drive for transfer of information between the card and the personal computer (e.g., as supported by Column 9, lines 2-4 of the specification).

In the Office Action dated February 19, 2002, the Examiner has indicated that claims 1 - 18, 25 - 30 and 37 - 44 are allowable, has required submission of the original patent (or an affidavit or declaration as to loss or accessibility) prior to allowance and has rejected claims 19 - 23, 31 - 35 and 43 under 35 U.S.C. §112, second paragraph as being indefinite. Favorable reconsideration of the subject application is respectfully requested in view of the following remarks.

Initially, the Examiner has indicated that the original patent, or an affidavit or declaration as to the loss or inaccessibility of the original patent, must be received before the reissue application can be allowed. Applicant acknowledges this requirement and will resolve this issue upon achieving resolution of all other remaining issues for the subject application.

The Examiner has rejected claims 19 - 23, 31 - 35 and 43 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner takes the position that the recitation of the data card being configured for direct insertion into a personal computer drive is indefinite since the recited feature does not appear to be provided by the data card, but rather by features of an adaptor which may be permanently disposed within a floppy disk drive to create a new and improved floppy disk

Amendment**U.S. Patent Application Serial No. 09/725,850**

drive. The Examiner further alleges that the claims are unclear with respect to claiming a data card or claiming the combination of a data card and an adaptor permanently disposed within a floppy disk drive, and that this uncertainty results in the metes and bounds of the claimed invention being indeterminable.

This rejection is respectfully traversed. Initially, claims 19, 31 and 43 recite the feature of a personal computer drive. This drive may include any type of computer drive, including the disk drive of one embodiment of the present invention including a permanently installed adaptor. It is respectfully submitted that the data card must still be configured for direct insertion within the drive. In other words, the data card must have a configuration (e.g., suitable dimensions) compatible with the drive to enable direct insertion of the card into the drive. Therefore, the recitation of the data card being configured for direct insertion into a personal computer drive is clear and definite and considered to comply with 35 U.S.C. §112, second paragraph. However, in order to expedite prosecution of the subject application, claims 19, 31 and 43 have been amended to recite the feature of the data card being directly insertable into a personal computer drive. Accordingly, claims 19, 31 and 43 and their corresponding dependent claims 20 - 23 and 32 - 25 and 44 are considered to comply with 35 U.S.C. §112, second paragraph.

Applicant acknowledges and appreciates the Examiner's withdrawal of the rejection made in the previous Office Action under 35 U.S.C. §112, first paragraph with regard to the use of the term "storage medium" in a portion of the claims. The Examiner further indicated that use of the term "storage medium" represents a broader term to set forth the medium without the addition of new matter. Since the application has been shown to overcome the issues within the Office Action as



Amendment**U.S. Patent Application Serial No. 09/725,850**

discussed above, the application is now considered to be in condition for allowance.

Applicant appreciates the Examiner's efforts to resolve outstanding issues in the subject application, and provides the following comments with respect to Examiner remarks in the Office Action. In particular, the Examiner takes the position that the claims comply with 35 U.S.C. §112, first paragraph, but alleges that the specification does not provide support for the claimed feature of the storage medium taking any forms other than a magnetic medium. The Examiner further characterized the disclosure language identified by Applicant as generic and boilerplate and insufficient to provide enablement for the storage medium taking other forms, such as CD or DVD.

Initially, claims must be given their broadest reasonable interpretation during examination. In other words, the claims must be interpreted as broadly as their terms allow, where the words of a claim are given their plain meaning absent a clear definition in the specification. M.P.E.P. §2111.01; In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The plain meaning of the claim words refers to interpretation of the words by those of ordinary skill in the art. M.P.E.P. §2111.01. The claim words are generally not limited in meaning based on the disclosure or showing in the specification. This is especially true for non-chemical cases. Id.

The subject application does not provide any definition for the term "storage medium" that is inconsistent with the plain meaning of that term. Accordingly, this term within the claims should be given the plain meaning of a storage medium as interpreted by one of ordinary skill in the art. Clearly, one of ordinary skill in the art is aware of several storage media in a variety of forms (e.g., magnetic, optical, etc.) suitable for use with a computer. Thus, the recited term "computer readable storage medium" in claims 19-23, 25-35 and 37-42 should be broadly construed to cover those

Amendment**U.S. Patent Application Serial No. 09/725,850**

media.

The Examiner correctly construed the claims during examination in their broadest reasonable interpretation to cover non-magnetic (e.g., optical) media. In fact, the Examiner explicitly stated in the first Office Action that the claims reciting a computer readable storage medium cover other (i.e., optical) media and rejected claims under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §102 and §103 based on U.S. Patent Nos. 5,579,296 (Smith) and 4,916,687 (Endo) that each disclose only an optical storage medium (i.e., the Examiner clearly construed the storage medium feature within the claims to be anticipated or disclosed by the optical storage media of these patents). The Examiner withdrew the rejections to the claims based upon the Smith and Endo patents in the present Office Action in response to the structural differences identified by Applicant between the data card recited in the claims and the devices disclosed in those patents. The Examiner further withdrew the rejection under 35 U.S.C. §112, first paragraph since the term “computer readable storage medium” recited within the claims is clearly supported by the specification (e.g., by various embodiments each employing a storage medium, such as a magnetic medium). Thus, the Examiner has examined the case with the storage medium feature construed with the broadest reasonable interpretation to cover non-magnetic media and finds the claims in compliance with statutory requirements (e.g., except for the 35 U.S.C. §112, second paragraph issue discussed above which is not related to the storage medium feature).

At this point, examination and claim construction by the Examiner are basically complete. The Examiner construed the claims broadly to include non-magnetic media in accordance with examination practice, raised rejections and subsequently withdrew the rejections to indicate

Amendment**U.S. Patent Application Serial No. 09/725,850**

allowability of the claims. The extraneous statements made by the Examiner basically attempt to define the scope of the specification and allowable claim terms after the fact and in a narrower fashion than that utilized during the examination. Since the claims have been examined and indicated as allowable with a broader construction, these extraneous statements made after allowability are irrelevant and have no bearing on patentability.

With respect to construction of the claims for infringement purposes, this procedure is handled by the courts and not by the Examiner. See In re Zletz at 1321. Further, infringement employs a different standard for claim interpretation than that used for examination. See M.P.E.P. §2111.01. Thus, an attempt by the Examiner to provide these statements to define claim scope for infringement purposes is beyond the Examiner's authority and most likely applying a different standard. If the Examiner considers the claims, given their broadest reasonable interpretation discussed above, to be unsupported by the specification, the appropriate action is to reject the claims under 35 U.S.C. §112, and not provide extraneous statements in an attempt to define the claim scope. In re Zletz at 1322. Since such a rejection was made and subsequently withdrawn as discussed above, the claims with their broadest reasonable interpretation (i.e., to cover various storage media (e.g., magnetic, optical, etc.)) are considered to be fully supported by the specification.

In addition to the foregoing, Applicant is in total disagreement with the Examiner's position that the specification does not support the storage medium taking forms other than a magnetic medium. Specifically, the present invention, as indicated by the application title and the preamble of originally filed claim 1, is directed toward a personal computer data card and method for transferring information between the card and a personal computer. In other words, the purpose of

Amendment**U.S. Patent Application Serial No. 09/725,850**

the present invention is to provide a card or disk that may be utilized simultaneously as both a data storage device and a business card or other type of advertisement media (e.g., See specification Column 4, lines 32 - 36 and Column 5, lines 1 - 5). The particular type of storage medium employed by the card is not essential and, in fact, the specification supports various modifications to the cards indicating this aspect and use of other storage media. In particular, the specification indicates that the disclosed embodiments are exemplary of the personal computer data card or disk of the present invention (e.g., See specification Column 4, lines 6 - 8). Further, the specification states that the disclosed embodiments represent only a few of the many ways of implementing the personal computer data card or disk (e.g., See specification Column 9, lines 62 - 65). In addition, the specification discloses that the personal computer data card or disk "may be applied for use with various types of floppy or other disk drives" (e.g., See specification Column 10, lines 36 - 38). Thus, the specification clearly indicates that the cards may be employed with various computer drives (e.g., CD, DVD, etc.) other than floppy (or magnetic media) disk drives and, therefore, may include various storage media (e.g., optical) compatible with those other drives.

The Examiner takes the position that the various sections in the specification identified by Applicant set forth essentially generic and boilerplate language that is not considered adequate to serve as enablement for the storage medium taking other forms, such as an optical medium (e.g., CD or DVD). However, the specification clearly indicates that the data card or disk may be applied for use with various drives (e.g., CD or DVD drives) other than a floppy disk drive. The assertion that this language is generic or boilerplate is clearly erroneous. One of ordinary skill in the art is readily aware of the various drives and storage media common to personal and other computer systems (e.g.,

Amendment

U.S. Patent Application Serial No. 09/725,850

CD, DVD, ZIP, etc.). The language in the specification specifically applies the present invention to those other drives and, therefore, provides adequate support for various types of storage media.

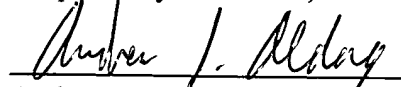
In addition, the Examiner takes the position that the language “computer readable storage means” in claims 43 and 44 is only met by a magnetic storage medium as the specification does not provide support for any other type of storage medium. However, 35 U.S.C. §112, 6th paragraph, recites that an element in a claim for a combination may be expressed as a means for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. The limitation in claims 43 and 44 of a “computer readable storage means for storing data and facilitating transfer of said data between said data card and said personal computer” invokes 35 U.S.C. §112, 6th paragraph. Accordingly, the computer readable storage means should be construed to cover the corresponding structure disclosed in the specification and equivalents thereof. M.P.E.P. §2111.01; In re Donaldson, 29 USPQ2d 1845 (Fed. Cir. 1994). As noted by the Examiner, a specific computer readable storage structure disclosed in the specification of the subject application is a magnetic medium. However, the specification further indicates that the present invention may be applied to other drives, thereby providing support for various other storage media as discussed above. In addition, one skilled in the art would readily recognize other computer readable storage structures, such as CD, DVD or other optical media storing data, as equivalents of a magnetic computer readable storage medium and covered by the claims. Therefore, the “computer readable storage means” limitation of claims 43 and 44 should be broadly construed to cover more than just a magnetic medium.

Amendment

U.S. Patent Application Serial No. 09/725,850

The application, having been shown to overcome issues raised in the Office Action, is considered to be in condition for allowance and a Notice of Allowance is earnestly solicited.

Respectfully submitted,


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